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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,812	01/13/2006	Matthew T Shea	109910-146667	3404
25943 7590 05/10/2010 Schwabe Williamson & Wyatt PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204				
EXAMINER LEICHLITER, CHASE E				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/564,812

**Applicant(s)**

SHEA ET AL.

**Examiner**

CHASE LEICHLITER

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date 03/03/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 13, 14, 17, and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 15-18 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir. 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirmse et al. (US 2002/0086732).

**Regarding claim 1**, Kirmse teaches a computer implemented method comprising:

- Facilitating composition at an inviter device an invitation comprising control information for formation of a multi-user session (P36 L1-3, P38 and P44);
- Transmitting said invitation to an instant messaging server for delivery to a recipient device associated with an instant messaging identifier (P44);
- Executing at said inviter device a process specified by said control information (P44);
- And if first multi-user session data is received from said recipient device, responding with second multi-user session data to said recipient device (P45).

**Regarding claim 15**, Kirmse teaches a computer implemented method comprising:

- Facilitating acceptance, at a recipient device, an instant message invitation, from an inviter device, comprising control information for formation of a multi-user session (P45 and P8 L4-9);
- In response to accepting said invitation, executing a process specified by said control information (P45);

- And transmitting to said inviter device data generated by said process to contribute to the formation of said multi-user session (P45).

**Regarding claim 2**, Kirmse teaches an invitation comprises a session ID of the multi-user session formed employing at least in part a user ID of an instant message service offered by the instant messaging server (P37, game data and P44, buddy list).

**Regarding claim 3**, Kirmse teaches an invitation comprises an IP address of said inviter device (P47).

**Regarding claims 4 and 16**, Kirmse teaches the method further comprises receiving said first multi-user session data via a relay server (P82, web server).

**Regarding claim 5**, Kirmse teaches responding comprises delivering said second multi-user session data to said relay server for relaying to said recipient device (P82).

**Regarding claim 6**, Kirmse teaches receiving an indication that a user at said recipient device has accepted said invitation (P45).

**Regarding claim 7**, Kirmse teaches invitation comprises an instant message (P36 L1-3 and P44).

**Regarding claim 8**, Kirmse teaches executing of a process performed automatically and unconditionally (P44).

**Regarding claim 9**, Kirmse teaches executing of a process occurs in response to an indication of a user at said recipient device accepting said invitation (P45).

**Regarding claim 10**, Kirmse teaches multi-user session is a multi-player game session, and said invitation comprises at least one game parameter of a game (P8 L4-9, P34 and P35).

**Regarding claim 11**, Kirmse teaches at least one game parameter specifies a type of game play (P47).

**Regarding claim 12**, Kirmse teaches at least one parameter specifies a game name for a user at the inviter device (P47).

**Regarding claims 13, 14, 17, and 18**, Kirmse teaches a processor and a memory containing computer executable instructions (P31).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lloyd et al. (US 6884172).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHASE LEICHLITER whose telephone number is (571)270-7109. The examiner can normally be reached on Monday through Friday 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571)272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. L./  
Examiner, Art Unit 3714

/Dmitry. Suhol/  
Supervisory Patent Examiner, Art  
Unit 3714